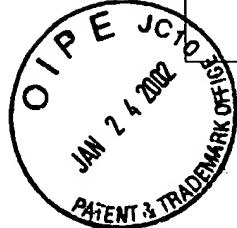


GP 2835

CERTIFICATE OF MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents and Trademarks, Washington, D.C. 20231, on December 28, 2001.

Joyce Tom



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Date: December 28, 2001

David W. HILL et al.

Serial No.: 09/335,201

Group Art Unit: 2835

Filed: June 17, 1999

Examiner: Vortman, A.

For: PC KEYBOARD WITH DETACHABLE SMARTCARD SECURITY DEVICE

Assistant Commissioner of Patents
Washington, D.C. 20231

TC 2300 MAIL ROOM

RECEIVED

FEB - 5 2002

TRANSMITTAL LETTER

Sir:

Submitted herewith are an original and two copies of an Appellant's Response to Examiner's Answer for the above-referenced patent application.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account 50-0563 (IBM Corporation). If any unresolved issues remain, please contact Applicant's attorney at the telephone number indicated below.

Respectfully submitted,



Joyce Tom
Attorney for Appellants
Reg. No. 48,681
(650) 493-4540

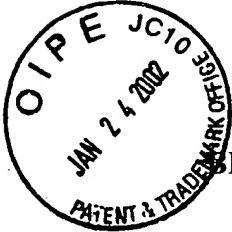
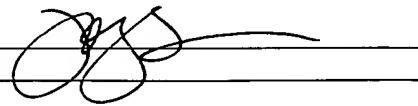
December 28, 2001

Date

CERTIFICATE OF MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents and Trademarks, Washington, D.C. 20231, on **December 28, 2001**.

Joyce Tom



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPEAL NO: To Be Assigned

In Re Application of: David W. HILL et al.

Serial No: 09/335,201

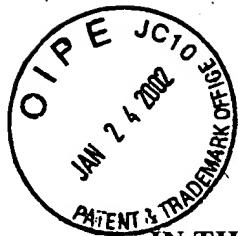
Filed: June 17, 1999

For: PC KEYBOARD WITH DETACHABLE SMARTCARD SECURITY DEVICE

RECEIVED
FEB - 5 2002
TC 2800 MAIL ROOM

APPELLANTS' RESPONSE TO EXAMINER'S ANSWER

Joyce Tom
Attorney for Appellants
International Business Machines Corp.
Sawyer Law Group, LLP
2465 E. Bayshore Road, Suite 406
Palo Alto, CA 94303



Attorney Docket: RP999082/1978P

RECEIVED

FEB -5 2002

TC 2300 MAIL ROOM

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Date: September 10, 2001

David W. HILL et al.

Serial No.: 09/335,201

Group Art Unit: 2835

Filed: June 17, 1999

Examiner: Vortman, A.

For: PC KEYBOARD WITH DETACHABLE SMARTCARD SECURITY DEVICE

Assistant Commissioner of Patents
Washington, D.C. 20231

APPELLANTS' RESPONSE TO EXAMINER'S ANSWER

I. REAL PARTY IN INTEREST

Appellants respectfully refer the Board to Appellants' Appeal Brief.

II. RELATED APPEALS AND INTERFERENCES

Appellants respectfully refer the Board to Appellants' Appeal Brief.

III. STATUS OF CLAIMS

In the Examiner's Answer, the Examiner states that claims 1-14 are pending in the present application and stand rejected. Originally, claims 1-10 were pending in the application, as filed. Claims 1, 6, and 7-10 were amended and claims 11-14 added in an Amendment dated

December 19, 2000. Appellants intended to cancel claims 13 and 14 in their Response to Final Office Action, dated May 10, 2001 (see page 1, ¶2; page 2, ¶1) in order to address the Examiner's objection to the drawings. Appellants, however, inadvertently failed to file a formal amendment to that effect.

At this time, Appellants respectfully request that claims 13 and 14 be cancelled and withdrawn from consideration. Appellants respectfully submit that claims 1-12 are on appeal and all applied rejections concerning *those* claims are herein being appealed.

IV. STATUS OF AMENDMENT

All amendments to claims 1-12 have been entered. Appellants respectfully request that claims 13 and 14 be cancelled.

V. SUMMARY OF THE INVENTION

Appellants respectfully refer the Board to Appellants' Appeal Brief.

VI. ISSUES

The issue presented is:

1. Whether claims 1-10 are anticipated by Knights (U.S. Patent No. 5,752,857) (Knights) under 35 U.S.C. § 102(b). While the Examiner states that only claims 1-8 are anticipated by Knights, later in the Examiner's Answer, the Examiner states that claims 1-10 are anticipated by Knights (see page 3, ¶2). This is consistent with the Final Office Action, dated February 13, 2001. Therefore, Appellants maintain that the Examiner has rejected claims 1-10 under 35 U.S.C. § 102(b) as being anticipated by Knights.

2. Whether claims 9-12 are anticipated by Arney et al. (U.S. Patent No. 4,749,364) (Arney) under 35 U.S.C. §102(b).

VII. GROUPING OF CLAIMS

In response to the Examiner's Answer, Appellant hereby states that claims 1-8, and 11-14 form one group. Claim 9 forms a second group, and claim 10 forms a third group.

VIII. RESPONSE TO EXAMINER'S ARGUMENTS

A. Examiner's First Point

Appellant contends that Knights fails to teach or suggest “a connecting assembly coupled to the body structure for attaching the body structure externally to the PC keyboard,” as recited in claim 1, or “a keyboard, wherein the connecting assembly is coupled externally to the keyboard,” as recited in claim 6, or “a keyboard, . . . the keyboard configured to receive the connecting assembly . . . such that the body structure is attached externally with the . . . keyboard,” as recited in claims 9 and 10. In response, the Examiner contends the “Fig. 7 of Knights clearly depicts that the body structure (180) of the accessory unit (i.e. the adapter) is attached externally to the keyboard (10), since the entire adapter (180) is *positioned externally* to the keyboard.” (Answer, page 6 (emphasis added)).

Appellant respectfully submits that being “*positioned*” externally to the keyboard is fundamentally different from being “*attached*” externally to the keyboard. According to Webster's Dictionary (College Edition 1995), the definition of the verb “attach” is “to fasten on or affix to: connect or join.” The definition of the verb “position” is “to place in proper position.” Being “attached” infers a physical connection with another object, whereas being

“positioned” infers proximity or spatial reference to another object. The two terms are not synonymous.

Appellant maintains that in Knights, the adapter is electrically and mechanically *attached* to the *IC card*, via the socket contacts and adapter plug. The adapter *is not* attached *externally* to the computer because the IC card is inserted *into* the computer. The IC card and, indirectly, the adapter are attached *internally* to the computer, i.e., the IC card is electrically and mechanically connected to a component (IC card slot) *inside* the computer. Moreover, the IC card *is not* a part of the computer; rather, it is a removable device that plugs into a computer via an IC card slot. Thus, while the adapter is connected to the IC card, it is not attached *to the computer*. In response, the Examiner states that the “IC card (14A) in conjunction with the keyboard (10) constitutes an integrated computer system, thus rendering the IC card to be a part of the computer. Following the Appellant’s reasoning one would not consider a microprocessor chip plugged into the socket on the computer motherboard to be a part of the computer either.” (Answer, Page 6).

Appellant respectfully submits that the IC card is a removable component, that when removed, *does not* affect the operational integrity of the computer. Appellant certainly agrees with the Examiner that a microprocessor chip plugged into a socket on the planar is part of the computer system. Nevertheless, unlike the IC card, if the microprocessor is removed, the computer’s operational integrity is impaired, i.e., the computer is inoperable. Following the Examiner’s reasoning, one would consider any removable component plugged into the computer’s port(s), e.g. a joy stick, a digital camera, a part of the computer.

Accordingly, Appellant maintains that Knights fails to teach or suggest “a connecting assembly coupled to the body structure for attaching the body structure *externally to the PC*

keyboard,” as recited in claim 1, or “a keyboard, wherein the connecting assembly is coupled externally to the keyboard,” as recited in claim 6, or “a keyboard, . . . the keyboard configured to receive the connecting assembly . . . such that the body structure is attached externally with the . . . keyboard,” as recited in claim 9 and 10.

B. Examiner’s Second Point

Nothing in Knights suggests or teaches attaching the body structure to the “PC *keyboard*,” as recited in claims 1, 6, 9 and 10. In the present invention, the body structure is attached externally to the keyboard via the connecting assembly. Because the body structure *is not* attached *internally*, it logically makes no electrical contact with the keyboard. In Knights, the adapter must be connected *electrically and mechanically* to the IC card, which in turn is inserted into the IC card slot of the computer. The IC card becomes electrically connected to the computer’s processing system via the slot.

Nothing in Knights teaches or suggests that Knights’ adapter/IC card can be attached externally to the *keyboard*, as opposed to the IC card slot. Indeed, this would make absolutely no sense because the IC card would not be able to make electrical contact with the computer if it were attached to the PC keyboard. Without an electrical contact with the computer, Knights’ adapter would be useless because the computer would not be able to access the contents of the Smartcard.

In response, the Examiner states that “since the present invention is also a Smartcard adapter, (page 2 of the present disclosure),” the accessory unit of the present invention must also have electrical contact with the computer. Appellant does not dispute this, but it is clear from the Specification that such electrical contact *is not* established via the connecting assembly, and

certainly not via the keyboard. For instance, on page 4 of the Specification, “[t]he Smartcard reader 12 has an outer case which defines a slot 18 for receiving a typical Smartcard, . . . and further defines a passage 20 for dressing an electrical cord connection between the PC Smartcard kit 10 and *an electrical connection and jack in any PC circuit or unit.*” (Specification, page 4, lines 12-15). Accordingly, Appellant maintains that Knights fails to teach or suggest attaching the body structure to the “PC keyboard,” as recited in claims 1, 6, 9 and 10.

C. Examiner’s Third Point

Knights’ adapter *is not* intended for use with a standard stand alone PC keyboard, as recited in claims 1, 6, 9 and 10. In Knights, the IC card slot into which the IC card is inserted is located on the side of a *computer device*, where electrical contact with the computer is possible. A notebook computer that *incorporates* a keyboard, as illustrated in Figure 1 of Knights, *is not* a stand alone keyboard.

In response, the Examiner offered definitions of a “keyboard” from the IEEE Standard Dictionary and from the Illustrated Dictionary of Electronics. Appellants *do not* contend that the device in Knights fails to include a keyboard, after all, most if not all notebook or laptop computers include an input device, such as a keyboard. Appellants *do* contend, however, that Knights’ device is not a *stand alone* keyboard, such as a that typically coupled to a desktop PC. In the present invention, the stand alone keyboard does not have the capability to communicate with the body structure. Indeed, the body structure is only *externally* attached to the keyboard. Accordingly, Knights fails to teach or suggest “attaching the body structure externally to the PC keyboard,” “the keyboard being a stand alone component,” as recited in claims 1, 6, 9 and 10.

For reasons discussed above, Appellants maintain that Knights fails to teach or suggest

the present invention, as recited in claims 1, 6, 9 and 10. Therefore, Applicants respectfully submit that claims 1, 6, 9 and 10 are allowable over Knights. Claims 2-5, and 7-8 depend on claims 1 and 6 respectively and the above arguments apply with equal force to these claims. Accordingly, Applicants respectfully submit that claims 2-5 and 7-8 are also allowable over Knights.

D. Examiner's Fourth Point

Appellants respectfully submit that Arney fails to teach or suggest “a keyboard, . . . the keyboard configured to receive the connecting assembly . . . such that the body structure is attached *externally* with the . . . keyboard,” as recited in claims 9 and 10. As stated above, the present invention provides that the body structure is attached externally to the keyboard. In Arney, the display 105 is plugged *into* the portable computer 101 via the sockets 103, i.e., the display 105 is attached *internally* to the computer 101. Thus, the display is *not* “attached externally” to the keyboard, as recited in claims 9 and 10.

In response, the Examiner states that “Arney is attached externally to the keyboard (101), as clearly shown in Fig. 1, (i.e., the body of the unit (105) is *positioned* outside of the keyboard (101)).” (Answer, page 9). Appellants reiterate their arguments presented above in response to the Examiner’s First Point, and maintain that the display in Arney is not “attached externally” to the keyboard, as recited in claims 9 and 10.

Furthermore, Arney does not teach or suggest attaching the display to the “keyboard, the keyboard being a stand alone component,” as recited in claims 9 and 10. Arney’s display is *not* intended for use with a standard *stand alone* PC keyboard, as recited in claims 9 and 10. Arney’s display must be connected to a *computer*, such as the portable computer illustrated in Figure 1.

Because the portable computer incorporates a keyboard, the keyboard *is not* a stand alone component.

In response, the Examiner considers Arney's device to be a stand alone keyboard based on the Examiner's Third Point. Appellants reiterate their response to the Examiner's Third Point, and maintain that Arney's portable computer illustrated in Figure 1 incorporates a keyboard, but is not a stand alone component.

Finally, the Examiner states that "the accessory unit disclosed in the instant application (Fig. 1), is also not connected to the keyboard externally as claimed in the instant application, but internally, since the connecting assembly (two-prong clip (28)) is accepted within the keyboard by openings (32, 34), (Fig. 3; page 5, lines 5 and 6 of the instant application)." (Answer, page 9).

While one embodiment of the present invention provides for inserting or extracting the legs of the clip device from openings or slots in the keyboard (Specification, page 5, lines 1-7), such openings or slots in the keyboard are designed to receive the legs. Nothing in the present invention states that the openings or slots provide *internal* attachment to the keyboard. Indeed, the slots or openings are more likely form molded features on the keyboard casing.

Accordingly, Arney fails to teach or suggest "a keyboard . . . configured to receive the connecting assembly and clip . . . , such that the body structure is attached externally with the . . . keyboard, the keyboard being a stand alone component," as recited in claims 9 and 10. Therefore, Appellants respectfully submit that claims 9 and 10 are allowable over Arney.

Claims 11 and 12 depend on independent claim 6. Like claims 9 and 10, claim 6 recites the features that distinguish claims 9 and 10 from Arney. Therefore, the arguments above relating to claims 9 and 10 apply with full force to claim 6, and in turn, to claims 11 and 12. Thus, Appellants respectfully submit that claims 11 and 12 are allowable over Arney.

IX. CONCLUSION

For the reasons set forth above, Appellants respectfully submit that the present invention, as recited in independent claims 1, 6, 9 and 10, is not taught or suggested by the cited references. Claims 1, 6, 9 and 10 are therefore allowable. Claims 2-5, 7-8, 11 and 12 depend from independent claims 1 and 6, respectively, and consequently the arguments herein apply with equal force and effect to dependent claims 2-5, 7-8, 11 and 12. Accordingly, Appellants respectfully submit that claims 2-5, 7-8, 11 and 12 are also allowable over the cited references.

Appellant respectfully requests that the final rejection of claims 1-12 be reversed.

Very truly yours,

December 28, 2001
Date


Joyce Tom
Attorney for Appellants
Reg. No. 48,681
(650) 493-4540